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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,962	01/23/2002	Kikukatsu Ito	2001_1838A	3213

513 7590 08/26/2003

WENDEROTH, LIND & PONACK, L.L.P.  
2033 K STREET N. W.  
SUITE 800  
WASHINGTON, DC 20006-1021

EXAMINER

MAYES, LAURIE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 08/26/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/009,962

Applicant(s)

ITO, KIKUKATSU

Examiner

Laurie Mayes

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 5, 6, drawn to a gene comprising cDNA and a DNA fragment.

Group II, claim(s) 3, 4, drawn to a thermogenic protein.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The DNA and protein of Group I and II have different structures and functions as the DNA encodes a protein while the protein may be used in an assay or to treat diabetes. Further, a DNA fragment comprising a partial sequence of SEQ ID NO: 1 is known in the art (see present claim 5)(WO 96/32483, SEQ ID NO: 130 and see attached copy of sequence alignment).

A telephone call was made to Lee Cheng on August 20, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Mayes whose telephone number is (703) 605-1208. The examiner can normally be reached on Monday through Friday from 9 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.

*L. Mayes*

Laurie Mayes  
Patent Examiner  
Art Unit 1653

*Christopher S. F. Low*

CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1800

Genome version 5.1.6  
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BLAST - nucleic search, using SW model

Run on: August 14, 2003, 19:05:48 : Search time 806.815 Seconds  
(without alignments)  
1412.743 Million cell updates/sec

Title: US-10-009-962-1  
Perfect score: 28  
Sequence: 1 CCGCGAAGACGTCCTTAAAGTCGAGG 28

Score table: IDENTITY\_NUC  
Gapop 10.0, bapext 1.0

Searched: 288711 seqs, 2045481386 residues  
Total number of hits satisfying chosen parameters: 5777422

Minimum LE seq length: 0  
Maximum LE seq length: 280000000

Post-processing: Minimum Match 0%  
Maximum Match 100%  
Listing first 45 summaries

Database: GenBank

GenBank

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- 2: db\_hgt\*
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- 6: db\_pat\*
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- 8: db\_pl\*
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- 41: em\_ba\*

Prod. No. is the number of results predicted by chance to have a

score greater than or equal to the score of the result being printed,  
and is derived by analysis of the total score distribution.

# SUMMARIES

Result No.	Score	% Match	Length	EB	ID	Description
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2	20	71.4	10277	1	AE009540	AE009540 Brucella
3	19.6	70.0	2322	8	AY120689	AY120689 Arabidops
4	19.6	70.0	2714	8	AF375436	AF375436 Arabidops
5	19.6	70.0	7142	1	PHMTX2AG	PHMTX2AG Arabidops
6	19.6	70.0	7142	6	AX385012	AX385012 Sequence
7	19.6	70.0	7142	6	AX385014	AX385014 Sequence
8	19.6	70.0	19768	2	AC098036	AC098036 Sequence
9	19.6	70.0	109016	8	ATT10K17	ATT10K17 Sequence
10	19.6	70.0	187649	2	AC124218	AC124218 Arabidops
11	19.6	70.0	193326	2	AC127443	AC127443 Rattus no
12	19.6	70.0	219635	2	AC123204	AC123204 Rattus no
13	19.6	70.0	231741	2	AC110855	AC110855 Rattus no
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18	19.2	68.6	144404	8	AP003210	AP003210 Oryza sat
19	19.2	68.6	172615	2	AC139765	AC139765 Homo sapi
20	19.2	68.6	176933	3	AC009350	AC009350 Arabidops
21	19.2	68.6	177028	3	AC008315	AC008315 Arabidops
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24	19.2	68.6	251872	2	AC125998	AC125998 Rattus no
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26	19	67.9	1557	6	AX13881	AX13881 Sequence
27	19	67.9	2062	1	BCE302064	BCE302064 Burkholder
28	19	67.9	2225	8	ATG30RPS5	ATG30RPS5 A. thaliana
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30	19	67.9	3882	3	CE14	CE14 Caenorhab
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36	19	67.9	187755	2	AC005718	AC005718 Caenorhab
37	19	67.9	228381	2	AC103252	AC103252 Rattus no
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45	19	67.9	403253	1	AP005240	AP005240 Bradyrhiz

## ALIGNMENTS

RESULT 1  
A57638/c  
LOCUS A57638  
DEFINITION Sequence 130 from Patent WO95/2483.  
ACCESSION A57638  
VERSION A57638.1 GI:3713470  
KEYWORDS  
SOURCE unclassified  
ORGANISM unclassified  
REFERENCE  
AUTHORS Masucci M.G.  
TITLE IMMUNE-EVADING PROTEINS  
JOURNAL Patent, WO 9632483-A 130 17-OCT-1996;  
MASUCCI MARIA GRAZIA (SE)

linear PAT 95-MAP-1998

